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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,697	05/17/2000	Paul W. Chau	SPY-022-C1	8633

7590 10/18/2007  
David R Graham  
1337 Chewpon Ave  
Milpitas, CA 95035

EXAMINER
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NGUYEN, VAN H

ART UNIT	PAPER NUMBER
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2194

MAIL DATE	DELIVERY MODE
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10/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/574,697

Applicant(s)

CHAU ET AL.

Examiner

VAN H. NGUYEN

Art Unit

2194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-9, 41, 43-54 and 57-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9, 41, 43-54, and 57-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### ***DETAILED ACTION***

1. This communication is responsive to the amendment filed 05/30/2007.

Claims 2-9, 41, 43-54, and 57-77 are currently pending in this application. Claims 43, 57, and 69 are independent claims.

### **Claim Objections**

2. Dependent claims 2-9, 41, 44-54, and 58-68, and 69-77 are objected to because of the following informalities: the phrase "An integrated circuit card interface device" should read "The integrated circuit card interface device". Appropriate correction is required.

### **Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 69-77 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite a "device" in the preamble only, the body of the claims *merely contains software components*. Therefore, the

Art Unit: 2194

claims are software per se and do not fall within one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture or composition of matter).

Claims which are broad enough to read on statutory subject matter or on non-statutory subject matter are considered non-statutory. Cf. In re Lintner, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972) ("Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter.") During prosecution, applicant can amend to limit the claims to statutory subject matter.

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-9, 41, 43-54, and 57-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gray et al.** (US 6557754) in view of **Cagliostro** (US 5500517).

**As to claim 43:**

Gray teaches an integrated circuit card interface device (card reader 20; see Fig.1B) comprising:

- an application memory (module 42, col. 4 lines 13-32)
- an application engine for managing one or more applications in said application memory (firmware which the processor 40 executes for operation of the card reader 20 and for monitoring data and/or commands from the computer 12, col. 4 lines 33-65)
- an input/output module (buffer for data inputs and outputs, col. 4 lines 33-65)
- a host interface (mode to enable the card 80 to communicate directly with a host computer, such as computer 12 (FIG. 1A), col. 6 line.52 - col. 7 lines 13); and
- one more integrated circuit card interfaces (circuits 105a and 105b, USB UART 224 or 226, processor 32 and firmware installed in memory 34, col. 8 line 49 - col. 9 line 8)
- wherein the interface device is adapted to enable operation in accordance with multiple modes of operation (reader interface circuit ... operable in two communication modes, col. 1 line 46 - col. 2 line 3).

Gray discloses a host device (a computer 12), an integrated circuit card interface device (card reader 20), and an integrated circuit card (a smartcard) (see Fig.1A and col.3, lines 13-41). Additionally, Gray discloses a card reader 20 comprising, among other things, memory 42, processor 40, card interface circuit 44 (see Fig.1B and col.4, lines 13-41). With all these components, the card reader 20 could operate in a “standalone mode” (without connecting to a host device), to read and/or write data to /from the card 30.

However, Gray does not specifically teach a standalone mode of operation in which the interface device is not operably connected (to a host device).

Cagliostro teaches teach a standalone mode of operation in which the interface device is not operably connected to a host device ([T]his invention relates generally to the transfer of data between integrated circuit smart card read/write terminals and a remote central computer, and more particularly to such smart card terminals which are stand alone terminals, i.e. which are not connected to the remote central computer during each transaction, col.1, lines 9-14; see also, col.3, lines 33-35).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Gray with Cagliostro because Cagliostro’s teaching would have facilitated communicating between integrated circuit smart card read/write device and a smartcard.

**As to claims 2-6:**

Gray (col. 4 lines 13-32) teaches the recited read-only memory, application memory, and an I/O controller.

**As to claims 7-9:**

Gray (col. 4 line 66 - col. 5 line 6) teaches the integrated card circuitry as recited.

**As to claim 41:**

Gray (col. 3 lines 44-61) teaches the integrated circuit card interface device is portable.

**As to claims 44-54:**

The combination of Gray and Cagliostro teaches the recited operation modes and connection configurations for interfacing the integrated circuit card to the system (Gray; col. 4 lines 33-65 et seq. and Cagliostro; col.1, lines 9-14; see also, col.3, lines 33-35).

**As to claim 57**

The rejection of claim 43 above is incorporated herein in full. Additionally, Gray teaches the interface device is adapted to enable operation in accordance with multiple modes of operation (reader interface circuit ... operable in two communication modes, col. 1 line 46 - col. 2 line 3) the multiple modes of operation comprising a programming mode of operation in which the interface device is operably connected to a integrated circuit card interfaces, and/or to a host device via the host interface, to enable one or more programs

to be added to, and/or deleted from, the interface device (ROM 42a includes firmware which the processor 40 executes for operation of the card reader 20 and for monitoring data and/or commands from the computer 12, col. 4 lines 13-32 et seq.).

**As to claims 58-67:**

Note the rejections of claims 44-54 supra.

**As to claim 68:**

Gray teaches a display unit and an input (see Fig. 1A and the associated text).

**As to claim 69:**

The rejection of claim 43 above is incorporated herein in full. Additionally, Gray teaches means for operably connecting the interface device to an integrated circuit card to enable communication between the interface device and the integrated circuit card (processor coupled to the reader interface circuit and the memory, communicates with the reader, col. 1 line 46 - col. 2 line 3);

- means for operably connecting the interface device to a host device to enable communication between the interface device and the host device (reader 50 then proceeds with normal operation, including entering a passive mode to enable the card 80 to communicate directly with a host computer, such as computer 12, col. 6 line 52 - col. 7 lines 13); and



- means for operating the interface device in a connected mode in which the interface device is operably connected to a host device to enable communication between the interface device and the host device (processor 40 executes for operation of the card reader 20 and for monitoring data and/or commands from the computer 12, col. 4 lines 13-32).

**As to claims 70-77:**

Note the rejections of claims 44-54 supra.

### **Response to Arguments**

5. Applicant's arguments filed on 05/30/2007 have been considered but are moot in view of the new ground(s) of rejection.

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." In re Hyatt 21 1 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (1989) "During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims

that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”

Applicant should set forth claims in language that clearly, distinctly, unambiguously, and uniquely define the invention.

### **Conclusion**

6. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

### **Contact Information**

7. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM-6:00PM. The examiner can also be reached on alternative Friday. If attempts to reach the

examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM THOMSON can be reached at (571) 272-3718.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



VAN H. NGUYEN  
PRIMARY EXAMINER